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PHARMACEUTICALS, INC.*

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

GILEAD SCIENCES, INC.,

Plaintiff,

v.

MERCK & CO, INC., MERCK SHARP &
DOHME CORP. and ISIS
PHARMACEUTICALS, INC.,

Defendants

Case No. 5:13-cv-04057-BLF/PSG

**STIPULATION AND
~~PROPOSED~~ ORDER**

1 Plaintiff and Counterdefendant Gilead Sciences, Inc. (“Gilead”) and Defendants and
2 Counterclaimants Merck & Co., Inc. (Defendant only), Merck Sharp & Dohme Corp., and Isis
3 Pharmaceuticals, Inc. (collectively, “Merck” or “Defendants”) hereby stipulate and agree as
4 follows:

5 WHEREAS Gilead did not present evidence in its case-in-chief that the Asserted Claims of
6 the ’499 and ’712 patents are invalid for failure to enable a person of ordinary skill in the art, as of
7 January 18, 2002, to make nucleosides with a 2’-C₁₋₄ alkyl or CF₃ up and 2’ Fluoro down
8 configuration without undue experimentation, and thus did not proceed with that specific
9 enablement argument;

10
11 NOW THEREFORE, it is stipulated that Claims 1 and 2 of U.S. Patent No. 7,105,499 (the
12 “’499 Patent) and Claims 1, 2, 3, 5, 7, 9, 10 and 11 of U.S. Patent No. 8,481,712 (the “’712
13 Patent”) (collectively, the “Asserted Claims”), based on this record, are not invalid for failure to
14 enable a person of ordinary skill in the art, as of January 18, 2002, to make nucleosides with a 2’-
15 C₁₋₄ alkyl or CF₃ up and 2’ Fluoro down configuration without undue experimentation, and this
16 asserted basis for invalidity is hereby dismissed with prejudice.

17
18 This stipulation does not affect Gilead’s other enablement arguments or Merck’s
19 forthcoming motion for judgment as a matter of law.

1 Dated: March 11, 2016

FISH & RICHARDSON P.C.

2
3 By: /s/ Elizabeth M. Flanagan
Elizabeth M. Flanagan

4 Attorneys for Plaintiff
5 GILEAD SCIENCES, INC.

6
7 Dated: March 11, 2016

HUGHES HUBBARD & REED LLP

8 By: /s/ Stephen S. Rabinowitz

9 Attorneys for Defendants
10 MERCK & CO., INC.; MERCK SHARP &
11 DOHME CORP.; ISIS PHARMACEUTICALS,
INC.

12 **SIGNATURE ATTESTATION**

13 Pursuant to Civil Local Rule 5.1(i)(3), I attest under penalty of perjury that concurrence in
14 the filing of this document has been obtained from its signatory

15 /s/ Stephen S. Rabinowitz

16
17
18 **PURSUANT TO STIPULATION, IT IS SO ORDERED**

19 March 14, 2016

20 Beth Labson Freeman
HONORABLE BETH LABSON FREEMAN

CERTIFICATE OF SERVICE

I certify that all counsel of record are being served on March 11, 2016 with a copy of this document via the Court's CM/ECF system.

/s/ Stephen S. Rabinowitz

STEPHEN S. RABINOWITZ